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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,251

09/10/2007

Thomas Bretschneider

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08/26/2010

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
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EXAMINER

HABTE, KAHSAY

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

08/26/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,251	<b>Applicant(s)</b> BRETSCHNEIDER ET AL.	
	<b>Examiner</b> Kahsay T. Habte	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 27, 28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-6, 27-28 and 30 are pending in this application.

### ***Response to Amendment***

2. Applicant's amendment filed 07/26/2010 in response to the previous Office Action (03/24/2010) is acknowledged. Rejection of claims 1-6, 27-28, 30-33 and 35 under 35 U.S.C. § 112, second paragraph (item 8) and the obviousness-type double patenting rejection (item 7) have been obviated. The other obviousness-type double patenting rejection (item 6) has been maintained.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6 and 27-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 6-8 of U.S. Patent No. 6,358,887. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is significant overlap between the instant claims and claims 1-3 and 6-8 of U.S. Patent No. 6,358,887 when formula (I) in '887 is defined as: X = halogen, Z = alkoxy and Y = alkyl.

### ***Response to arguments***

Applicant's argument filed 07/26/2010 has been fully considered but it is not persuasive.

Applicants argue that "The '887 patent claims recite a very large genus of compounds...Therefore, the claims of the '887 patent do not point to a 'typical,'

'preferred,' or 'optimum' species or subgenus that would point one of skill in the art to the claimed subject matter...Therefore, the claims of the '887 patent do not render obvious the claims of the instant invention". The examiner disagrees with applicant's argument. The instant claims and claims 1-3 and 6-8 of U.S. Patent No. 6,358,887 are not patentably distinct from each other because there is significant overlap between the instant claims and claims 1-3 of U.S. Patent No. 6,358,887 when formula (I) in '887 is defined as: X = halogen, Z = alkoxy and Y = alkyl. This obviousness-type double patenting rejection is based on anticipation and not based on *prima facie* case of obviousness type rejection.

In regard to the declaration submitted by Dr. Wolfgang, it is not relevant to this obviousness-type double patenting rejection. Please see below applicant's remark:

Even assuming that a *prima facie* case of obviousness has been established, which it has not, the unexpected herbicidal action exhibited by the claimed compounds is sufficient to overcome any *prima facie* case of obviousness. Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 ("Declaration") which recites the unexpected superiority of the claimed invention over compounds falling within the claims of the '887 patent. In the Declaration, chemist Dr. Wolfgang Thielert, recites data comparing the insecticidal action of the compounds of the present invention to compounds falling within the claims of the '887 Patent. The specific compounds listed in the Declaration were filed during the patent examination procedure of EP 0809629, which is the European equivalent of the '887 patent. A copy of the list of compounds submitted to the EPO during prosecution of EP 0909629 is attached.

Since there is significant overlap between the instant claims and claims 1-3 and 6-8 of U.S. Patent No. 6,358,887, applicants have to file a terminal disclaimer to overcome this rejection.

***Objection***

5. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571)-272-0667. The examiner can normally be reached on M-F (9.00- 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kahsay T. Habte/  
Primary Examiner, Art Unit 1624

August 26, 2010